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Patent
Case No.: 59492US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: KLUN, THOMAS P.
Application No.: 10/751142 Group Art Unit: 1625
Filed: December 31, 2003 Examiner: H. M. Reyes
Title: PROCESS FOR PREPARING FLUORO-CHEMICAL MONOISOCYANATES

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]	
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<input checked="" type="checkbox"/>	transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.
Jan. 17, 2005 Date	<i>Lisa P. Fulton</i> Signed by: Lisa P. Fulton

Dear Sir:

This is in response to the Office Action mailed December 15, 2004.

REMARKS

Claims 1 - 19 are pending. Claims 1 - 19 were restricted under 35 USC § 121 as follows:

- I. Claims 1 - 15 and 19 in part are said to be drawn to a catalyzed process for preparing fluorinated diisocyanates wherein the catalyst is selected from those described in claims 14 and 15 and the required solvent is a non-polar solvent;
- II. Claims 1 - 15 and 19 in part are said to be drawn to a catalyzed process for preparing fluorinated diisocyanates wherein the catalyst is not selected from those described in claims 14 and 15 and the required solvent is a non-polar solvent;
- III. Claims 1 - 15 and 19 in part are said to be drawn to a non-catalyzed process for preparing fluorinated diisocyanates wherein the required solvent is a non-polar solvent;
- IV. Claims 1 - 15 and 19 in part are said to be drawn to a non-catalyzed process for preparing fluorinated diisocyanates wherein the required solvent is not a non-polar solvent; and

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V. Claims 16 – 18 drawn to compositions comprising diisocyanates, classified in multiple classes and subclasses.

In addition, a single disclosed species has been requested for search purposes.

Applicants hereby provisionally elect Group III with heptane as the required solvent species with traverse. Applicants respectfully submit that the Restriction Requirement is improper for the following reasons.

Groups I, II, and III all relate to a process for preparing monoisocyanates. A catalyst is not required by the independent claim, claim 1 (although use of a catalyst is certainly allowed by the open term "comprising"). If claim 1 were found to be patentable as written (that is, without requiring a catalyst), then claim 1 would automatically be patentable with the added requirement of using a catalyst. Applicants are therefore confused by the Examiner's restriction based upon "catalyzed" and "non catalyzed" categories.

Applicants respectfully request reconsideration of the Restriction Requirement and removal of the restriction based upon the "catalyzed" and "non catalyzed" categories.

CONCLUSION

Applicants have elected Group III with heptane as the required solvent species. Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723.

Respectfully submitted,

Jan. 17, 2005
Date

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